

REMARKS

Applicants thank the Examiner for acknowledging the claim for priority under 35 U.S.C. § 119, and receipt of a certified copy of the priority document Japanese Application 2002-218742 submitted July 22, 2003. Applicants thank the Examiner for considering the references cited with the Information Disclosure Statement filed July 22, 2003, but Applicants respectfully request that the Examiner consider and initial the Information Disclosure Statement filed September 29, 2005. Further, Applicants thank the Examiner for indicating that the Formal Drawings filed July 22, 2003 are accepted.

Status of the Application

Claims 1-49 are all the claims pending in the Application. Claims 1-3, 5-7, 9, 11-26, 29-34, 39-49 are amended to more clearly define the invention, and to address the Examiner's claim rejections under 35 U.S.C. § 112. These are merely clarifying amendments, and are not believed to narrow the scope of the claims in any way, and no estoppel is intended.

Allowable Subject Matter

The Examiner objects to claim 7 as being dependent upon a rejected base claim. Applicant thanks the Examiner for indicating that claim 7 would be allowed if rewritten in independent form. However, instead of rewriting claim 7 in independent form, Applicant respectfully traverses the prior art rejections for the reasons set forth below.

Claim Rejections 35 U.S.C. § 112, 2nd Paragraph

The Examiner has rejected claims 1, 5, 22 and 30 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The indefiniteness by the Examiner has been corrected in the above mentioned claim amendments. Thus, withdrawal of the rejection is respectfully requested.

Claims Rejections - 35 U.S.C § 102(a) as Anticipated by Nishino et al.

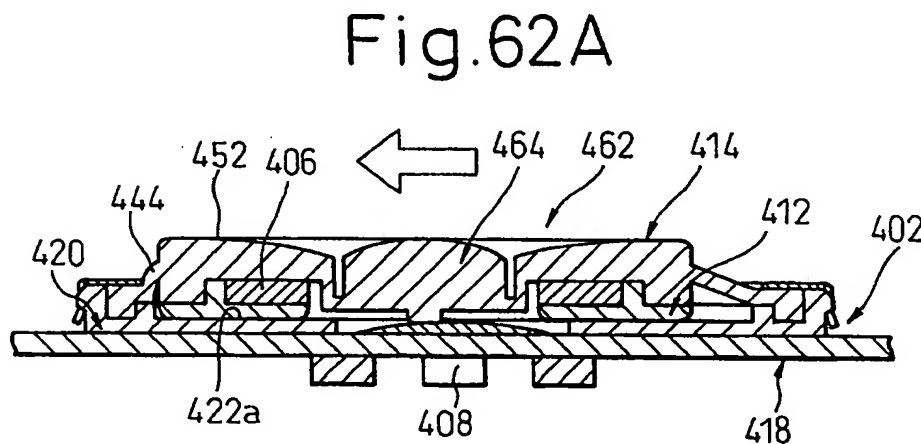
The Examiner has rejected claims 1, 2 and 4 under 35 U.S.C. § 102(a) as being anticipated by Nishino et al. (US Patent Application 2002/0097224; hereinafter “Nishino”). This rejection is respectfully traversed.

Claim 1

Applicants respectfully submit that Nishino fails to disclose, at least, a sliding key that is fixed on the outside of an elastic sheet, as recited in independent claim 1.

Nishino discloses a pointing device 460 formed in a layered fashion. (Fig. 60) The layers, starting from the outermost portion, consist of: (1) an outer cover 428a having a circular opening 430; (2) an elastic part 414 which is a button type actuating part; (3) a magnet 406 below the elastic part 414; (4) a holding part 412; and (5) a support member 420. (See Fig. 60). The Examiner seems to allege that the elastic part 414 corresponds to the recited “elastic sheet,” and that actuating part 464, operating surface 452, and major portion 444 correspond to the recited “sliding key.” (Office Action pg. 3). Applicants respectfully disagree.

Applicant's respectfully submit that the portions of Nishino cited by the Examiner fail to disclose both recited features, i.e., the elastic sheet and the sliding key as recited in independent claim 1. The portions cited by the Examiner, *inter alia*, elastic part 414, operating surface 452 and major portion 444 are not discrete elements and thus do not disclose both the: (1) elastic sheet, and (2) sliding key of independent claim 1. For example, Figure 62A of Nishino (shown below), clearly



shows that major portion 444 and operating surface 452 are merely sub-portions of a single elastic part 414. “Particularly, in the pointing device 460, the elastic part 414, and the actuating part 464 of the operating section 462 are integrated with each other, which advantageously decreases the number of components and improves the operability of the assembling process.” See pg. 26, par. [0294]. Based on this interpretation, then the part 414 cannot disclose both “a sliding key that is fixed on the outside surface of said elastic sheet,” and the “elastic sheet,” as the sliding key is merely an area of the elastic sheet, not a separable feature fixed thereupon.

On the other hand, if the Examiner is interpreting Nishino such that somehow these portions 444, 453 and 464 form a contiguous part including elastic part 414, then Nishino is deficient for failing to disclose “an elastic sheet having an outside surface disposed on an inside surface of said cabinet including said opening.” Logically, if the Examiner intends to separate these elements into discrete objects, the portion allegedly disclosing the “elastic sheet” fails to meet the criteria of claim 1. If elastic part 414, actuating part 464 and major portion 444 are discrete elements, then elastic part 414 cannot be said to be disposed on an inside part of said cabinet including said opening, as recited in claim 1. In fact, under this view, elastic part 414 is neither disposed across said opening, nor is it disposed on an inside surface of said cabinet. It merely lies between major portion 444 and the actuating part 464.

Because under any of the possible readings of Nishino, all the features of independent claim 1 are not disclosed, Applicant respectfully submits that claim 1 is allowable over the cited reference. Further, claims 2 and 4 are allowable, at least by virtue of the dependency on claim 1, and also by the features recited therein.

Claims Rejections - 35 U.S.C § 103(a) over Nishino

The Examiner has rejected claim 3 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nishino. This rejection is respectfully traversed.

The Examiner alleges that Nishino discloses most of the features of claim 3, but concedes Nishino does not teach a space formed on a part of the rear surface and the edge part of said rim being disposed in said space. To make up this deficiency, the Examiner merely states that it would have been obvious to one of ordinary skill in the art at the time of the invention to include

a space formed on the rear surface of the cabinet such that the edge part or the rim resides in space for the purpose of preventing friction caused by direct contact of the rear surface and the elastic part 444, thus providing a better environment for the movement of the sliding key. (Office Action, pg. 5)

Applicant agrees with the Examiner that Nishino is deficient as noted above. However, Applicant respectfully points out that the additional remarks by the Examiner, alleging that several features would be obvious to one of ordinary skill in the art, are merely conclusory. The prior art reference must teach or suggest all the claim limitations. MPEP § 2142 (establishing a prima facie case of obviousness). Further, in order to take official notice without documentary evidence, as the Examiner has done, specific factual findings based on sound technical evidence and scientific reasoning to support a conclusion of common knowledge must be provided. MPEP § 2144.03B. The Examiner has failed to do so within the Office Action. Finally, Applicant respectfully submits that the deficiencies of Nishino go beyond what the Examiner has acknowledged.

Applicants respectfully submit that one of ordinary skill in the art would not modify Nishino as the Examiner has alleged primarily because the pointing device disclosed therein does not slide within the case. For example, Nishino discloses that second connecting portion 448 serves to fixedly connect elastic part 414 to holding part 412 and base section 402. (*See* Fig. 62, par. [0279]). Thus, because Nishino teaches away from making the Examiner's proposed combination, there is no motivation to combine the references.

Further, the alleged motivation by the Examiner in this instance does not make up the deficiencies of Nishino as discussed with regard to independent claim 1 from which claim 3 depends.

For at least the reasons noted above, Applicants respectfully submit that claim 3 is patentable over the applied combination.

Claims Rejections - 35 U.S.C § 103(a) over Nishino in view of Yasuda

The Examiner has rejected claims 5, 6, 8-17, 21-24 and 26-49 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nishino, in view of Yasuda (US 5,012,230). This rejection is respectfully traversed.

Applicants respectfully submit that the cited combination fails to teach or suggest, at least, an elastic sheet having an outside surface disposed on an inside surface of said cabinet including said opening, and a sliding key that is fixed on the outside surface of said elastic sheet, as recited in independent claims 5, 22 and 30. Nishino is deficient with regard to these features as discussed in relation to claim 1 above. Further, Yasuda does not make up this deficiency.

Thus, Applicants respectfully submit that independent claims 5, 22 and 30 are patentable over the applied combination for at least these reasons. Further, claims 6, 8-18, 21, 23-24, 26-29 and 31-49 are patentable, at least, by virtue of their dependency from the aforementioned independent claims, and also for the features cited therein.

Claims Rejections - 35 U.S.C § 103(a) over Nishino in view of Yasuda in further view of Hill et al.

The Examiner has rejected claims 18, 19 and 20 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nishino in view of Yasuda in further view of Hill et al. (US Patent Application 2003/0206154; hereinafter “Hill”). This rejection is respectfully traversed.

Applicants respectfully submit that the cited combination fails to teach or suggest, at least, an elastic sheet having an outside surface disposed on an inside surface of said cabinet including said opening, and a sliding key that is fixed on the outside surface of said elastic sheet, as recited in independent claims 1 and 5 from which claims 18, 19 and 20 depend. Nishino is deficient with regard to these features as discussed in relation to claim 1 above. Further, neither Yasuda nor Hill make up this deficiency.

Thus, Applicants respectfully submit that claims 18, 19 and 20 are patentable at least by virtue of their dependency, and also for the features recited therein.

Conclusion

In view of the foregoing, it is respectfully submitted that claims 1-49 are allowable. Thus, it is respectfully submitted that the application now is in condition for allowance with all of the claims 1-49.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111 Atty. Dkt. No. Q76655
U.S. Application No. 10/623,568

Please charge any fees which may be required to maintain the pendency of this application, except for the Issue Fee, to our Deposit Account No. 19-4880.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. Emery', is written over a horizontal line.

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